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10/821,033

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David R. Ginskey

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EXAMINER

GARCIA JR, RENE

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,033

Applicant(s)

GINSKEY, DAVID R.

Examiner

Rene Garcia, Jr.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 10-13, 19 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 2 3 4 7 10 11 12 13 19 23 24 25 26 27 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/24/06.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 1 recites the limitation "the tip" in line 7. There is insufficient antecedent basis for this limitation in the claim.

2. Claim 23 is objected to because of the following informalities: line 3 contains spelling error: "adated" should be "adapted". Appropriate correction is required.

3. Claims 27 & 28 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims provide no further method for cleaning a print head only structural limitations are recited. It has been held that to be entitled to weight in method claims, the recited-structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer, 1962 C.D. 408 (1961)*.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 is dependent upon cancelled claim 6 and therefore examiner is unsure to what scope of the invention claim now is based on.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 7, 10-13, 19, 23, 24, 25, 26 & 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Kotaki (US 2003/0007029).

Kotaki discloses the following claimed limitations:

*regarding claims 1, 23 & 26, system for cleaning a print head/**ink ejection opening**,
Surface A/
(paragraph 0093; fig. 3A) of an inkjet cartridge/**ink jet cartridge**, 8/ (fig. 1) of a printer
(paragraph 0003), said print head having a total number of ejection ports/**ink ejection openings**,
G/ (fig. 3B & 4; paragraph 0093) thereon, comprising: (paragraph 0022 & 0024)

*sealing member/**elastic member**, 1/ having first and second ends (fig. 1, 2A, 2B & 4;
paragraph 0088)

*conduit defined by said member (fig. 4)

*first opening of said conduit at said first end of said sealing member, said first opening
having a cross-sectional area, said first end of said sealing member being fluidly connected to
and receivable onto and in sealed relation to the tip of a syringe/**syringe pump/** (paragraph
0106), said syringe being usable to control the pressure in said conduit (paragraph 0099 & 0106;
paragraphs 0099-0105 disclose cross-sectional area relationship)

*second opening of said conduit at said second end of said sealing member, said second opening having a second cross-sectional area, said second opening of said conduit being adapted to form sealed fluid communications with one of said number of ejection ports (fig. 4)

*regarding claim 7, first end of said member defines a stem engaging internal surface for engagedly receiving and holding a stem on said tip of said syringe (fig. 9B & 11A; second end [upper portion where cap guide, 30 and tube, 40 meet, forming recovery cap, C] first end [lower part of tube, 40])

*Examiner assumes that claim 7 is meant to depend upon claim 1 for examination purposes

*further regarding claims 10, 23, 24 & 26, second opening is adapted to fluidly communicate with a plurality of said ejection ports at once (paragraph 0081; fig. 18B)

*regarding claim 11, cross-sectional area of said second opening is larger than the cross-sectional area of said first opening (fig. 11A; paragraphs 0013 – 16)

*regarding claims 12 & 28, conduit widens cross-sectionally from said first end/**lower portion of tube, 40/** to said second end/**upper portion where cap guide, 30 and tube, 40 meet, forming recovery cap, C/** (fig. 9B & 11A)

*regarding claims 13, 25 & 26, second opening is defined in a printhead engaging sealing surface, said sealing surface creating said sealed fluid communication with one of said plurality

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of said ejection ports/**ink passage, 41/** (fig. 11A & 11B; acting pressures 01-04 are in relation to an ejection port)

*Regarding claim 26, no recitation is present in relation to when first and second tips are provided to tip of syringe, only providing a first and second tip

*regarding claim 19, second opening is adapted to fluidly communicate with substantially all of the plurality of ejection ports at once (fig. 11A; paragraphs 0013-0016)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-4 & 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotaki (US 2003/0007029) in view of Maerzke (US 5,709,253).

Kotaki disclose the following claimed limitations:

*regarding claim 4, second opening is defined in a printhead engaging sealing surface, said sealing surface creating said sealed fluid communication with one of said number of ejection ports (fig. 4)

Kotaki does not disclose the following claimed limitations:

*regarding claim 2, cross-sectional area of said second opening is smaller than the cross-sectional area of said first opening

*regarding claims 3 & 27, conduit narrows cross-sectionally from said first end to said second end

Maerzke discloses the following:

*regarding claim 2, cross-sectional area of said second opening is smaller than the cross-sectional area of said first opening/**tapered luer 9A/** (fig. 1; tapered luer/9A/ inserted into adapter/5/ for connection to print cartridge) for the purpose of forming a tight seal

*regarding claims 3 & 27, conduit narrows cross-sectionally from said first end to said second end/**tapered luer 9A/** (fig. 1; tapered luer/9A/ inserted into adapter/5/ for connection to print cartridge) for the purpose of forming a tight seal

It would have been obvious at the time the invention was made to a person having ordinary skill in the to utilize a cross-sectional area of said second opening is smaller than the cross-sectional area of said first opening; and conduit narrows cross-sectionally from said first end to said second end as taught by Maerzke into Kotaki for the purpose of forming a tight seal

Response to Arguments

10. Applicant's arguments filed 24 July 2006 have been fully considered but they are not persuasive.

11. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Arguments presented only give a general reasoning based on pliable tips and uses specific for cleaning without providing specific claims the arguments are in reference too, further responses below details arguments as best interpreted by examiner.

12. In response to applicant's argument that Kotaki (US 2003/0007029) nor Maerzke (US 5,709,253) teaches use of a pliable syringe-mountable tips for cleaning the ports of a cartridge, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Kotaki teaches (paragraph 0011 & abstract) using suction to remove ink and air bubbles and as a consequence of such action debris in ink passages, therefore cleaning process. Kotaki further teaches that cap or elastic member/1/ is formed of a pliable/rubbery flexible material (paragraph 0088).

13. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., pliable tips) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant has failed to particularly define which claims are in question regarding this issue. Claims 1-4, 7, 10-13 & 19 provide no recitation regarding tips being pliable, while claims 23-28 do provide such recitation. However Kotaki does teach suggest features (paragraph 0088)

14. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., tapered or flared embodiments) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner assumes the

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argument presented on page 7, last paragraph, is in regards to claims 2, 3 [tapered] & 11, 12 [flared] and further related to newly presented claims 27 & 28. Claims 2, 3, 11 & 12 are broad limitations that while may be the intention to be tapered and flared recitations, the claim language allows for the broadest interpretation as presented in rejections above. As presented above the same rejection applies to claims 27 & 28 (note there is a claim objection with regards to 27 & 28) with support of figures 11a of Kotaki and figure 1 of Maerzke.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Communication with the USPTO

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rene Garcia, Jr. whose telephone number is (571) 272-5980. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Rene Garcia Jr
09/06


STEPHEN MEIER
SUPERVISORY PATENT EXAMINER